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R E M A R K S

Claims 1-18 are pending in the present application. Claims 1, 2, 4, 5, 12, and 13 are amended by this amendment. No new matter is introduced by the amendments and new claims, which find support throughout the specification and figures. In particular, the amendments are supported at least at figures 6 and 7 and page 11, line 25, to page 12, line 18, in the specification. It is respectfully submitted that the amendments do not raise new issues, clarify issues for appeal, and/or place the claims in condition for allowance. Therefore it is respectfully requested that the amendments be entered. In view of the amendments and the following remarks, Applicants respectfully request that the pending claims be allowed.

Applicants respectfully request that the finality of the rejection be withdrawn based on the incompleteness of the rejection with regard to claims 14-18, which are not discussed in detail. The Examiner is reminded that it is the duty of the Examiner to specifically point out each and every limitation of a claim being rejected as per §1.104(c)(2) of Title 37 of the Code of Federal Regulations and section 707 of the M.P.E.P., which explicitly states that "the particular part relied on must be designated" and "the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified". Since new claims 14-18 are not discussed in detail in the Office Action, Applicants are unable to properly respond to the Office Action, and therefore the finality of the rejection should be withdrawn.

Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 5,835,087 to Herz (hereinafter referred to as Herz). Applicants respectfully traverse.

With respect to the digital content being activated in a game program, the Examiner asserts that the "game program" limitation, as compared to the news program of Herz, is an obvious variation. The Examiner further asserts that changing the environment of a well known

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process does not make the claims patentable (Office Action; page 4, section 4). The Examiner further asserts that there is no fundamental difference between the news clipping program and the game program recited, and that the same steps are performed in Herz as in the present invention (Office Action; page 4, section 5).

However, the present invention significantly differs from Herz in that this invention relates to the in-contents advertising method or the digital contents distribution system, while Herz relates to a news clipping service that may deliver news articles (or advertisements and coupons for purchasables) (column 60, lines 11 to 12, the specification as filed). Therefore it is respectfully submitted that Herz does not render obvious the unamended claims.

Additionally, in the interest of expediting prosecution, claim 1 has been amended to clarify that advertisement information *provided beforehand will be inserted into digital contents based on information indicating that advertisements may be inserted* within the digital contents, and *advertising information included in the digital contents is updated with the retrieved advertising information*. In particular, claim 1 now recites inserting the retrieved advertising information in the digital contents *based on information indicating that advertisements may be inserted* when the digital contents are activated in the game program in the user terminal by the user, so that *advertising information included in the digital contents is updated with the retrieved advertising information*. Thus, the independent claims of the present application clearly define the feature of this invention that advertisement information provided beforehand is inserted into digital contents based on information indicating that advertisements may be inserted within the digital contents. In stark contrast, the news clipping services of Herz do not use the information indicating that advertisements may be inserted. Herz fails to disclose

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or suggest the information, and therefore the claims are allowable over Herz for at least this reason. Therefore, for at least this reason, claim 1 is allowable.

Claims 2, 3, and 14 depend from claim 1 and are therefore allowable for at least the same reasons as claim 1 is allowable.

Additionally, claim 2 further clarifies that the information indicating that advertisements may be inserted is included in the digital contents. It is respectfully submitted that Herz does not disclose or suggest this feature.

Claims 4, 5, 12, and 13 include features similar to those discussed above in regard to claims 1 and 2, and therefore, for at least the same reasons claims 1 and 2 are allowable, claims 4, 5, 12, and 13 are also allowable.

Claims 6-11 and 15-18 depend from one of claims 4, 5, 12, and 13, and are therefore allowable for at least the same reasons as their respective base claims are allowable.

Furthermore, the Examiner asserts that the motivation to modify the news service in Herz to a game program to attract younger users (Office Action; page 3, lines 6-9). However, this conclusory reasoning is insufficient to support a claim of obviousness. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either *explicitly or implicitly in the references themselves or in the knowledge generally available* to one of ordinary skill in the art. (MPEP 2143.01, emphasis added). "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

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The Federal Circuit addressed the standard for obviousness and the requirement of motivation in *Teleflex, Inc. et al. v. KSR Int'l Co.*, (119 Fed. Appx. 282; 2005 U.S. App. LEXIS 176). The patent at issue in *Teleflex*, related to an electronic pedal position control and a pedal assembly. In *Teleflex*, the district court granted a motion for summary judgment based on invalidity due to obviousness. The Federal Circuit vacated the decision and remanded to the lower court for further proceedings on the issue of obviousness. The Federal Circuit stated that, in regard to obviousness, "a person of ordinary skill in the art must not only have had some motivation to combine the prior art teachings, *but some motivation to combine the prior art teachings in the particular manner claimed.*" (*Teleflex*, citing *In re Kozab*; emphasis added). The Federal Circuit found that there was no motivation to combine the Asano patent, which disclosed all of the limitations except the electronic control, and the Rixon patent, which disclosed an electronic control and an adjustable pedal assembly. As the court further stated:

[t]he district court correctly noted that the nature of the problem to be solved may, under appropriate circumstances, provide a suggestion or motivation to combine prior art references. However, the *test requires that the nature of the problem to be solved be such that it would have led a person of ordinary skill in the art to combine the prior art teachings in the particular manner claimed.*

(*Teleflex*, citing as background *Rouffet*, 149 F.3d at 1357; emphasis added).

It is respectfully submitted that the present rejection is similar to the rejection discussed in *Teleflex* in that there is no motivation provided in Herz to combine its teaching with a game program. Herz apparently discusses an electronic news clipping service. However, there is no motivation in Herz to suggest a combination with a game program. The purported motivation to modify Herz supplied in the Office Action is insufficient in that neither Herz, nor any other references, indicates a desire or need to attract young users. Nor does a need to attract young

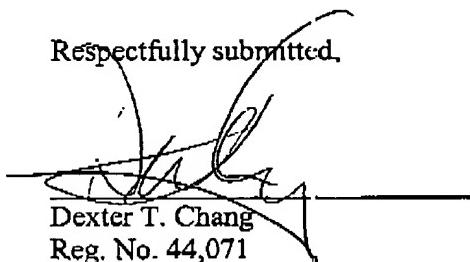
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users lead to the modification of the news service in Herz to a game program, as asserted by the Examiner. As the *Teleflex* court held, there must be *specific teaching* to motivate a person of ordinary skill in the art must to combine the prior art teachings *in the particular manner claimed*. Therefore, since there is no motivation to combine the references, the rejection is improper.

### CONCLUSION

In view of the remarks set forth above, this application is believed to be in condition for allowance which action is respectfully requested. However, if for any reason the Examiner should consider this application not to be in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

Any fee due with this paper may be charged to Deposit Account No. 50-1290.

Respectfully submitted,  
  
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